

AF *zzw*
3736

TRANSMITTAL OF REPLY BRIEF

Docket No.
29888/36772A

In re Application of: Gabriel Raviv et al.

Application No.
09/901,244-Conf. #8384

Filing Date
July 9, 2001

Examiner
Charles A. Marmor II

Group Art Unit
3736

Invention: EAR PROBE TIP

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Reply Brief in this application, with respect to the Examiner's Answer dated: August 9, 2005

☐ A petition for extension of time is also enclosed.

The fee for the extension of time is _____

☐ Charge the amount of the fee to Deposit Account No. _____
This sheet is submitted in duplicate.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 13-2855
This sheet is submitted in duplicate.

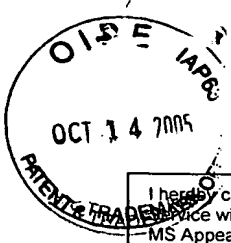
Dated: October 11, 2005

Anthony G. Sitko
Attorney Reg. No. : 36,278
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: October 11, 2005

Signature (Anthony G. Sitko)



I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: October 11, 2005

Signature:

(Anthony G. Silko)

Docket No.: 29888/36772A
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:

Gabriel Raviv

Confirmation No.: 8384

Application No.: 09/901,244

Art Unit: 3736

Filed: July 9, 2001

Examiner: Charles A.
Marmor II

For: Ear Probe Tip

APPLICANTS' REPLY BRIEF

MS Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This Reply Brief is filed in response to the Examiner's Answer mailed August 9, 2005, under 37 C.F.R. § 1.193(b)(1) in triplicate. This Reply Brief is timely filed on Tuesday, October 11, 2005, which is the first business day following October 9, 2005.

The Examiner's Answer, in short, is that little or no patentable weight is to be accorded the probe structure recited in the pending claims that provides a framework and defines the structure of the claimed ear probe tip. As such, the examiner asserts that the remaining limitations of the claims must stand alone, and unless these remaining limitations patentably distinguish the claimed invention, the claims are properly rejected. As the rejections of the claims improperly ignore the structure of the probe in defining the structure of the ear probe tip, structure which clearly distinguishes over the prior art, they are incorrect in view of Federal Circuit precedent and Office rules. The Board should reverse the examiner's rejection of the pending claims and remand the case to the Examiner for appropriate action in accordance therewith.

The Preamble and Related Recited Structure Limit the Claimed Structure

The examiner's assertion that the preamble of claim 60 recites only an intended use of the invention is incorrect. The recitation of the probe provides a framework against which the patentability of the claimed ear probe is measured. See *In re Stencel*, 828 F.2d 751, 754-5; 4 USPQ 2d 1071, 1073 (Fed. Cir. 1987) (structure of claimed driver defined in terms of structure of collar recited in the preamble). Here, as in *Stencel*, the particular physical structure of the ear probe tip is defined in terms of corresponding structure appearing in the preamble, namely, the probe. The probe is defined within the preamble so as to provide proper antecedent basis for later recitation of the probe structure when it is used to define the structure of the claimed ear probe tip. The structure of the probe could as easily appear within the body of the claim and would not change the scope of the claim because whether or not the structure of the probe appears in the preamble or in the body of the claim, the probe itself is not part of the claimed invention. Instead the structure of the probe serves to impose upon the claimed ear probe tip particular structural characteristics. *Id*; See also, MPEP 2111.02. As such, the recitation of the probe structure in the claims is not a statement of intended use, but it is instead defining and limiting of the structure of the ear probe tip and must be given patentable weight. As the ear probe tip so defined distinguishes over the cited art, the claims are allowable.

The Rejection of the Claims is Contrary to Patent Office Rules of Practice

As the Manual of Patent Examining Procedure (MPEP) succinctly points out, “[d]uring examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference...between the claimed invention and the prior art. If so, the recitation serves to limit the claim.” See MPEP 2111.02, citing *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Thus, if structure defined in the preamble of the claim results in a difference in the claimed structure that distinguishes the claim over the prior art, it serves to limit the claim.

The preamble of claim 60 recites the structure of the probe at least requiring the probe to have a length and a probe end. The claimed structure of the ear probe tip requires, *inter alia*, a particular relationship between a length and a second opening of a passage of the ear probe tip in respect of the probe length and the probe end. Specifically, the second opening is disposed proximately to the probe end, when the probe is received within the passage. This structural requirement of the ear probe tip results in the elimination of a portion of the passage of the ear probe tip forming an “acoustic channel.” Elimination of the ear probe tip forming a portion of the acoustic channel results in improved performance and reduced calibration requirements, which is not taught anywhere in the cited references. Thus, since the ear probe tip as defined in view of the structure of the probe, and in particular the recited relationship between the probe end and the second opening of the ear probe tip, distinguish the claims over the cited art, the claims are allowable over the cited references. As such, the rejections should be reversed.

The recited elements are not inherent in the prior art

In the Answer, the examiner appears further to take the position that each of the prior art devices inherently includes the limitations recited by the claims of the instant application. The examiner states that “given the myriad of known types of ear probes that exist in the medical arts, it is a near certainty that a [sic] ear probe exists that is capable of being used with the ear probe tip of Baum in a fashion such that the body portion of the Baum probe tip will have the same length as the probe tip to be covered...” Ex. Answer, p. 5.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teaching of the prior art.” MPEP 2112 (IV), citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in the original).

The applicants respectfully submit that the examiner has failed to make a *prima facie* case of inherency. The examiner improperly concludes based upon conjecture and without any supporting facts or prior art showing that such a probe exists, that there must be such a probe. The examiner simply fails to provide any basis in fact for reaching this conclusion and thus fails in his burden of establishing a *prima facie* case of inherency. Furthermore, that a certain result or characteristic may occur or be present in the prior art, that alone is not sufficient to establish the inherency of that result or characteristic. *Id.*

CONCLUSION

For the foregoing reasons, and the reasons set forth in their Appeal Brief, the applicants respectfully request reversal of the rejections of claims 60-72, and remand of the application to the examiner for action consistent therewith.

Respectfully submitted,

By:



Anthony G. Sitko
Registration No. 36,278
MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
312-474-6300

October 11, 2005